

REMARKS/ARGUMENTS

Claims 10-25 remain in the application.

Claims 17, 19 and 20 are currently amended.

Claims 26-34 are newly presented.

Claim Rejections Under 35 USC § 103

Claims 10, 12, 14, 19 and 20-23 were rejected under 35 USC § 103(a) over US Patent 2,807,908 to Lykes in view of US Patent 5,722,691 to Patel.

The invention of claim 19 is clearly patentable over Lykes and Patel, both individually and in combination.

The holding device of Lykes requires **(item 1)** a large back board (main back member 1) and **(item 2)** a protruding lip or shelf rest 2 upon which a book 63 is placed. Column 1, lines 61-63. The holding device of Lykes further requires **(items 3 and 4)** two elastic cords 5 fitted across the back board 1 from top to bottom between two slots 3 in the top edge of the back board 1 and two slots 4 in the self 2 along the bottom edge of the board 1. Column 2, lines 22-41 and Figures 1 and 5. These two elastic cords 5 each cross the pages on only one side of the book, and further cross the page from top to bottom of the book.

Lykes also requires a secondary retaining element formed of a bar 7 **(item 5)** and a spring or elastic band 8 **(item 6)** with the bar 7 mounted across the width of the back board 1 and over the pages of the book 63 for holding the pages of the book 63 against the back board 1 so the pages lie flat or are protected from a breeze or draught that could disturb them. "The bar is placed over the front of the book, and the elastic or spring behind the main back 1." Column 2, lines 42-59 (quoting column 2, lines 50-51).

Thus, Lykes requires no less than six different components to accomplish the function provided by the present invention. Lykes requires: **(item 1)** a large back board; **(item 2)** a protruding lip or shelf rest 2; **(items 3 and 4)** two elastic cords 5, one for each side of the book; **(item 5)** secondary retaining bar 7; and **(item 6)** spring or elastic band 8 for retaining bar 7.

In contrast, the present invention consists of only two parts: the support bar and a single resilient elastic retainer, as recited in claim 19.

Note that the omission of an element and retention of its function is an indicia of unobviousness. *In re Edge*, 359 F.2d 896,149 USPQ 556 (CCPA 1966) as recited in MPEP § 2144.04 (II)(B).

Thus, by law, the present invention is unobvious over Lykes as omitting one or more elements and retaining its function.

The present invention omits, for example, the two elastic cords 5 (**items 3 and 4**) that are required by Lykes to run lengthwise of the book with one being provided for each side of the book, one for holding pages against the book's front cover, and one for holding pages against the book's back cover. Yet, the single elastic retainer of the present invention provides this function by running across the book and holding the pages against both the front and back covers at once.

For at least this reason, the invention of claim 10 is patentable over Lykes.

The present invention also omits, for example, the secondary retaining element formed of a bar 7 (**item 5**) and the spring or elastic band 8 (**item 6**) that retains it. Yet, the single elastic retainer of the present invention also provides this function while providing the function of the two elastic cords 5 (**items 3 and 4**). Thus, the present invention provides the functions of four elements: items 3, 4, 5 and 6, in a single elastic retainer element.

For at least this additional reason, the invention of claim 10 is further patentable over Lykes.

Furthermore, the Examiner admits, and the Applicant agrees, that Lykes fails to disclose or suggest the support bar being substantially flat, nor the support bar comprising compacting means.

Patel cannot be combined with Lykes because no combination of Patel and Lykes results in the support bar and a single resilient elastic retainer of the present invention. Lykes, as discussed above, already requires too many elements to accomplish the function of the present invention. Combination with Patel cannot reduce the number of elements required by Lykes to provide the function of the present invention.

For at least this reason, the present invention is patentable over the combination of Lykes with Patel.

Furthermore, Lykes cannot be combined with Patel, except in a manner that is against the teachings of both and render both unsatisfactory for its intended purpose.

According to the Office Action mailed July 28, 2005, the Examiner relies on the bar 7 and spring or elastic band 8 of the secondary retaining element of Lykes in combination with the rectangular member 20 of Patel and the means for folding it for rejecting claim 10 to the present invention. However, the bar 7 of Lykes is intended to be laid over the pages of the book, with the spring or elastic band 8 stretching around under the book covers. In contrast, the rectangular member 20 of Patel is intended to lie under the covers of opened book 12, with pages 14a and 14b being held in place by adjustable holding clips 40 and 60. Column 3, lines 50-53, as follows:

FIG. 1 shows the page holder device 10 in a fully opened position and in an operational mode which has a book 12 opened with pages 14a and 14b being held in place by adjustable holding clips 40 and 60. Column 3, lines 50-53.

Any combination of Patel with Lykes requires reversing the positions of the elements. Either the bar 7 of Lykes must be moved to under the book covers with the spring or elastic band 8 stretching over the pages so the bar 7 cannot hold down the pages, which is its intended purpose; or the rectangular member 20 of Patel must be moved to over the pages with the holding clips 40 and 60 under the book covers so rectangular member 20 cannot position the clips 40 and 60 for holding the pages, which is its intended purpose.

Therefore, Lykes and Patel cannot be combined because such combination would render both unsatisfactory for its intended purpose.

Additionally, the Examiner has failed to point out any suggestion or motivation to combine Lykes and Patel, as required by law. The Examiner is reminded that a statement that modifications of the prior art to meet the claimed invention would have been " 'well within the ordinary skill of the art at the time the claimed invention was made' " because the references relied upon teach that all aspects of the claimed invention were individually known in the art is not sufficient to establish a prima facie case of obviousness without some objective reason to combine the teachings of the references. *Ex parte Levengood*, 28 USPQ2d 1300 (Bd. Pat. App. & Inter. 1993). See also *Al-Site Corp. v. VSI Int'l Inc.*, 174 F.3d 1308, 50 USPQ2d 1161 (Fed. Cir. 1999) (The level of skill in the art cannot be relied upon to provide the suggestion to combine references) as recited in MPEP § 2143.01.

Furthermore, because any combination of Lykes and Patel would render both unsatisfactory for its intended purpose, there is no suggestion or motivation to make the proposed

modification. *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984) as recited in MPEP § 2143.01.

The only support member taught by Lykes is the large back board (main back member 1). Although the Examiner has argued that the bar 7 of Lykes substitutes for the support member of the present invention, the teaching of Lykes does not supports this argument. Rather, as taught by Lykes, the bar 7 is only effective to hold the pages against a breeze or draught that could disturb them. Column 2, lines 42-46. "The bar is placed over the front of the book, and the elastic or spring behind the main back 1." Column 2, lines 42-59 (quoting column 2, lines 50-51). Thus, Lykes provides absolutely no teaching that bar 7 is sufficient for supporting the book without the main back member 1. Accordingly, the main back member 1 must be the book support member.

The main back member 1 of Lykes must be wide to accommodate the protruding lip or shelf rest 2 upon which a book 63 is placed. Column 1, lines 61-63. Thus, attempting to combine the narrow rectangular member 20 of Patel with the main back member 1 of Lykes will necessarily render the main back member 1 of Lykes unsatisfactory for its intended purpose. For at least this further reason, Patel cannot be combined with Lykes.

Even if Lykes could be combined with Patel, which it cannot, Patel fails to provide the deficiencies of Lykes. Even if the hinge of Patel was combined with the main back member 1 of Lykes, the main back member 1 of Lykes would still not include means for compacting. Rather, the protruding lip or shelf rest 2 upon which a book 63 is placed would render impossible compacting the main back member 1. Additionally, the supporting plate 16, friction hinge 17, and bolt and nut assembly 18 on the back of the main back member 1 for attaching it to leg 11 and base 13 upon which it stands would prevent any compacting of main back member 1. Therefore, hinge 30 of Patel cannot provide the means for compacting the support bar, as required by claim 19.

Furthermore, there is absolutely no teaching or suggestion that providing means for compacting the main back member 1 of Lykes would not render the holding device of Lykes unsatisfactory for its intended purpose. Rather, it appears clear to the Applicant that providing means for compacting the main back member 1 of Lykes would render the holding device of Lykes unsatisfactory for its intended purpose.

Therefore, for at least the above reasons, Patel cannot provide the deficiencies of Lykes.

For at least the above reasons, claim 19 is believed to be allowable.

Claims 10, 12 and 14 are allowable at least as depending from allowable claim 19.

Claim 20 differs in scope from allowable claim 19. However, the above arguments directed to claim 19 are sufficiently applicable to claim 20 as to make repetition unnecessary. Thus, for each of the reasons above, claim 20 is believed to be allowable over the cited art. Claims 21-23 are allowable at least as depending from allowable claim 20.

Claims 11 and 24 were rejected under 35 USC § 103(a) over US Patent 2,807,908 to Lykes in view of US Patent 5,722,691 to Patel.

As discussed above, the inventions of claims 19 and 20 are clearly patentable over Lykes and Patel, both individually and in combination.

Claims 11 and 24 are allowable at least as depending from allowable claims 19 and 20, respectively.

Claims 15-17 were rejected under 35 USC § 103(a) over US Patent 2,807,908 to Lykes in view of US Patent 6,453,589 to Schwartz.

As discussed above, the invention of claim 19 is clearly patentable over Lykes. Schwartz merely teaches a file folder. See, e.g., Abstract. Therefore, Schwartz fails to provide the deficiencies of Lykes.

Claims 15-17 are allowable at least as depending from allowable claim 19.

Claim 17 at least is further allowable independently of base claim 19 as reciting a plurality of the anchoring means formed at one of the first and second opposite ends of the elastic retainer, and further as being spaced at intervals along the elastic retainer, as currently amended. The Office Action rejected claim 17 only as depending from intervening claim 15, without addressing the merits of claim 17 independent of intervening claim 15.

Nothing in the cited references discloses or suggests providing a plurality of the anchoring means formed at one of the first and second opposite ends of the elastic retainer, as originally recited in claim 17. Therefore, claim 17 is believed to be allowable as originally presented.

The current amendment of claim 17 is provided only for further clarification and is not believed to be necessary for patentability.

Claims 13 was rejected under 35 USC § 103(a) over US Patent 2,807,908 to Lykes in view of US Patent 4,462,614 to Krause.

As discussed above, the invention of claim 19 is clearly patentable over Lykes. Krause merely teaches a book marker. See, e.g., Abstract. Therefore, Krause fails to provide the deficiencies of Lykes.

Claim 13 is allowable at least as depending from allowable claim 19.

Claims 18 and 25 were rejected under 35 USC § 103(a) over US Patent 2,807,908 to Lykes in view of US Patent 5,722,691 to Patel and further in view of US Patent 4,462,614 to Krause.

As discussed above, the inventions of claim 19 is clearly patentable over Lykes, Patel and Krause, both individually and in combination.

Claims 18 and 25 are allowable at least as depending from allowable claim 19.

Newly Presented Claims

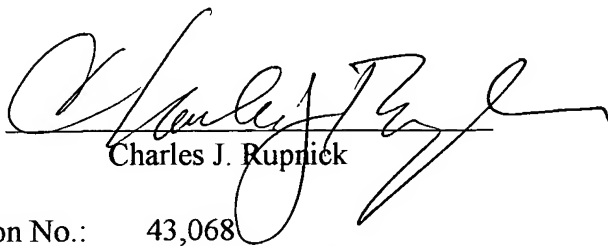
Claims 26-34 are newly presented. Newly presented claims 26-34 are consistent with previously presented claims 10-25. No new matter is presented. Newly presented claims 26-34 differs in scope from allowable claims 10-25. However, the above arguments directed to claims 10-25 are sufficiently applicable to claims 26-34 as to make repetition unnecessary. Thus, for each of the reasons above, claims 26-34 are believed to be allowable over the cited art.

The claims now being in form for allowance, reconsideration and allowance is respectfully requested.

If the Examiner has questions or wishes to discuss any aspect of the case, the Examiner is encouraged to contact the undersigned at the telephone number given below.

Respectfully submitted,

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